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Attorney Docket No.: 10351.200-US PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Yaver et al. Confirmation No: 8797

Serial No.: 10/716,793 Group Art Unit: 1653

Filed: November 18, 2003 Examiner: To be assigned

For: Promoter Variants For Expressing Genes In A Fungal Cell

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

Mail Stop: Restriction Req.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby certify that the attached correspondence comprising:

1. Response to Restriction Requirement

is being deposited with the United States Postal Service as first class mail in an envelope addressed to the address indicated above on October 28, 2005.

Seleste A. Buriani
(name of person mailing paper)

Seleste A. Buriani
(signature of person mailing paper)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Yaver *et al.* Confirmation No. 8797

Serial No.: 10/716,793 Group Art Unit: 1636

Filed: November 18, 2003 Examiner: Lambertson, D.A.

For: Promoter Variants For Expressing Genes In A Fungal Cell

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This paper is being filed in response to the Office Action mailed October 21, 2005, that made restriction requirements. Applicants were requested to elect one of twenty-two designated groups under 35 U.S.C. § 121:

Group 1: Claims 1, 10, 25, 27, 28, 30, 31 and 90 are drawn to a method of producing a biological substance comprising operably linking a first nucleic acid of interest encoding the biological substance to a second nucleic acid of interest comprising a promoter variant or hybrid comprising SEQ ID NO: 2 or a subsequence thereof, classified in class 435, subclass 41.

Group 2: Claims 1, 10, 25, 27, 28, 30, 31 and 90 are drawn to a method of producing a biological substance comprising operably linking a first nucleic acid of interest encoding the biological substance to a second nucleic acid of interest comprising a promoter variant or hybrid comprising SEQ ID NO: 3 or a subsequence thereof, classified in class 435, subclass 41.

Group 3: Claims 1, 10, 25, 27, 28, 30, 31 and 90 are drawn to a method of producing a biological substance comprising operably linking a first nucleic acid of interest encoding the biological substance to a second nucleic acid of interest comprising a promoter variant or hybrid comprising SEQ ID NO: 4 or a subsequence thereof, classified in class 435, subclass 41.

Group 4: Claims 1, 10, 25, 27, 28, 30, 31 and 90 are drawn to a method of producing a biological substance comprising operably linking a first nucleic acid of interest encoding the

biological substance to a second nucleic acid of interest comprising a promoter variant or hybrid comprising SEQ ID NO: 5 or a subsequence thereof, classified in class 435, subclass 41.

Group 5: Claims 1, 10, 26, 27, 28, 30, 31 and 90 are drawn to a method of producing a biological substance comprising operably linking a first nucleic acid of interest encoding the biological substance to a second nucleic acid of interest comprising a promoter variant or hybrid comprising SEQ ID NO: 6 or a subsequence thereof, classified in class 435, subclass 41.

Group 6: Claims 1, 10, 26, 27, 28, 30, 31 and 90 are drawn to a method of producing a biological substance comprising operably linking a first nucleic acid of interest encoding the biological substance to a second nucleic acid of interest comprising a promoter variant or hybrid comprising SEQ ID NO: 7 or a subsequence thereof, classified in class 435, subclass 41.

Group 7: Claims 1, 10, 26, 27, 28, 30, 31 and 90 are drawn to a method of producing a biological substance comprising operably linking a first nucleic acid of interest encoding the biological substance to a second nucleic acid of interest comprising a promoter variant or hybrid comprising SEQ ID NO: 8 or a subsequence thereof, classified in class 435, subclass 41.

Group 8: Claims 1, 10,26,27,28,30,31 and 90 are drawn to a method of producing a biological substance comprising operably linking a first nucleic acid of interest encoding the biological substance to a second nucleic acid of interest comprising a promoter variant or hybrid comprising SEQ ID NO: 9 or a subsequence thereof, classified in class 435, subclass 41.

Group 9: Claims 1, 10, 26, 27, 28, 30, 31 and 90 are drawn to a method of producing a biological substance comprising operably linking a first nucleic acid of interest encoding the biological substance to a second nucleic acid of interest comprising a promoter variant or hybrid comprising SEQ ID NO: 10 or a subsequence thereof, classified in class 435, subclass 41.

Group 10: Claims 1, 10, 26, 27, 28, 30, 31 and 90 are drawn to a method of producing a biological substance comprising operably linking a first nucleic acid of interest encoding the biological substance to a second nucleic acid of interest comprising a promoter variant or hybrid comprising SEQ ID NO: 11 or a subsequence thereof, classified in class 435, subclass 41.

Group 11: Claims 1, 10, 26, 27, 28, 30, 31 and 90 are drawn to a method of producing a biological substance comprising operably linking a first nucleic acid of interest encoding the biological substance to a second nucleic acid of interest comprising a promoter variant or hybrid comprising SEQ ID NO: 12 or a subsequence thereof, classified in class 435, subclass 41.

Group 12: Claims 53, 62, 77, 79, 80, 82, 83 and 87-89 are drawn to a promoter element or hybrid comprising SEQ ID NO: 2 or subsequences thereof. Vectors comprising said promoter and host cells comprising said vector, classified in class 536, subclass 24.1.

Group 13: Claims 53, 62, 77,79, 80, 82, 83 and 87-89 are drawn to a promoter element or hybrid comprising SEQ ID NO: 3 or subsequences thereof. Vectors comprising said promoter and host cells comprising said vector, classified in class 536, subclass 24.1.

Group 14: Claims 53, 62, 77, 79, 80, 82, 83 and 87-89 are drawn to a promoter element or hybrid comprising SEQ ID NO: 4 or subsequences thereof. Vectors comprising said promoter and host cells comprising said vector, classified in class 536, subclass 24.1.

Group 15: Claims 53, 62, 77, 79, 80, 82, 83 and 87-89 are drawn to a promoter element or hybrid comprising SEQ ID NO: 5 or subsequences thereof. Vectors comprising said promoter and host cells comprising said vector, classified in class 536, subclass 24.1.

Group 16: Claims 53, 62, 78-80, 82, 83 and 87-89 are drawn to a promoter element or hybrid comprising SEQ ID NO: 6 or subsequences thereof. Vectors comprising said promoter and host cells comprising said vector, classified in class 536, subclass 24.1.

Group 17. Claims 53, 62, 78-80, 82, 83 and 87-89 are drawn to a promoter element or hybrid comprising SEQ ID NO: 7 or subsequences thereof. Vectors comprising said promoter and host cells comprising said vector, classified in class 536, subclass 24.1.

Group 18: Claims 53, 62, 78-80, 82, 83 and 87-89 are drawn to a promoter element or hybrid comprising SEQ ID NO: 8 or subsequences thereof. Vectors comprising said promoter and host cells comprising said vector, classified in class 536, subclass 24.1.

Group 19: Claims 53, 62, 78-80, 82, 83 and 87-89 are drawn to a promoter element or hybrid comprising SEQ ID NO: 9 or subsequences thereof. Vectors comprising said promoter and host cells comprising said vector, classified in class 536, subclass 24.1.

Group 20: Claims 53, 62, 78-80, 82, 83 and 87-89 are drawn to a promoter element or hybrid comprising SEQ ID NO: 10 or subsequences thereof. Vectors comprising said promoter and host cells comprising said vector, classified in class 536, subclass 24.1.

Group 21: Claims 53, 62, 78-80, 82, 83 and 87-89 are drawn to a promoter element or hybrid comprising SEQ ID NO: 11 or subsequences thereof. Vectors comprising said promoter and host cells comprising said vector, classified in class 536, subclass 24.1.

Group 22: Claims 53, 62, 78-80, 82, 83 and 87-89 are drawn to a promoter element or hybrid comprising SEQ ID NO: 12 or subsequences thereof. Vectors comprising said promoter and host cells comprising said vector, classified in class 536, subclass 24.1.

In response to these requirements, Applicants hereby elect the invention of Group 4 with traverse. Claims 1, 10, 25, 27, 28, 30, 31 and 90 read on the elected subject matter.

The basis of the traverse is that, while the inventions of Groups 4 and 15 are distinct, they are not independent of each other since they both involve the promoter variant of SEQ ID NO: 5. Searches of the non-patent literature for each of these inventions would not be a burden on the Office because they are co-extensive since they both require involvement of SEQ ID NO: 5.

Applicants are also required to elect a species of a hybrid promoter as it relates to the sequences. Applicants hereby elect a hybrid between SEQ ID NO: 5 and SEQ ID NO: 3 (or subsequences thereof) with traverse.

The basis of the traverse is that a hybrid promoter can comprise a portion of one or more promoters of the present invention; a portion of a promoter of the present invention and a portion of another promoter, *e.g.*, a leader sequence of one promoter and the transcription start site from the other promoter; or a portion of one or more promoters of the present invention and a portion of one or more other promoters. The other promoter may be any promoter sequence which shows transcriptional activity in the fungal host cell of choice including a mutant, truncated, and hybrid promoter, and may be obtained from genes encoding extracellular or intracellular polypeptides either homologous or heterologous to the host cell. Such an election places a severe burden on Applicants to realize the full scope of protection provided by the claims as filed.

The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this response or application.

Respectfully submitted,

Date: October 28, 2005

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